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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,882	10/04/2000	Timothy Lang	A20-015	5846

7590 03/11/2003
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EXAMINER

LILLING, HERBERT J

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/647,882

Applicant(s)

LANG ET AL.

Examiner

HERBERT J LILLING

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24, 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) 14, 15 and 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 16, 40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 14, 15 and 17-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. Receipt is acknowledged of the response filed December 13, 2002.

2. Claims 1-24 and 40-41 are now pending in this application.

Claims 25-39 have been cancelled.

Claims 14-15 and 17 have been withdrawn as drawn to the non-elected species and Claims 18-24 have been withdrawn as drawn to the non-elected invention from further consideration pursuant to 37 CFR 1.142(b), as being drawn to the nonelected species and inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No.12.

The arguments have been deemed not to be persuasive. It is noted that the intermediate and final product are considered to be related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a food nutrient by itself and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

It is considered that the food product containing the specific mixture does not maintain its properties of not containing soluble solids in the food products according to the specification.

However, if the following is on the record:

Applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case;

this Examiner will consider withdrawing the restriction requirement based on the above requirements:

The restriction has been made **FINAL**.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-13, 16 and ~~40-42~~ are rendered vague and indefinite by the expression "soluble solids" because the composition of the extract is only defined by the process of its preparation, which includes the solvent for the preparation of the additive. Such product-by-process claims are intended to define products, which are otherwise difficult to define and/or distinguish from the prior art except, by the process of making. Since the nature of the resulting extract will depend on the conditions of the extraction and the solvent used. For example, at what temperature is the extraction performed? Is

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the extract obtained via extraction with water, a polar solvent, a non-polar solvent, or an acid or base, or is it a squeezed extract? It is well accepted in the natural products and herbal art, that extraction of a biological source with one of various distinct solvents has a profound impact on the final product with respect to the presence, amounts, and/or ratios of active ingredients obtained, and, thus, on the ability of the extract to provide the desired functional effect(s) claimed and/or disclosed. Since the extract itself is clearly essential to the instantly claimed invention, the step(s) by which the claimed extract is/are obtained is/are also clearly essential and, therefore, must be recited in the claims (i.e., as a product-by-process). Although the claims are interpreted in light of the specification, critical limitations from the specification cannot be read into the claims (see, e.g., *In re Van Guens*, 988 F.2d 1181, 26 PSPG2d 1057 (Ded. Cir. 1991)). Accordingly, without the recitation of all these critical limitations as set forth above, the claims do not adequately define the instant invention.

The language of the claims must make it clear what subject matter the claims encompass to adequately delineate their "metes and bounds". The scope of the instant claims with respect to these "derived from fibre extracts" are vague and indefinite since one would not expect the components to be the same for different fruits or vegetables. See, e.g., the following decisions: *In re Hammack*, 427 F 2d. 1378, 1382, 166 USPQ 204, 208 (CCPA 1970); *In re Venezia* 530 F 2d. 956, 958, 189 USPQ 149, 151 (CCPA 1976); *In re Goffe*, 526 F 2d. 1393, 1397, 188 USPQ 131, 135 (CCPA 1975); *In re Watson*, 517 F 2d. 465, 477, 186 USPQ 11, 20 (CCPA 1975); *In re Knowlton* 481 F 2d. 1357, 1366, 178 USPQ 486, 492 (CCPA 1973). The courts have also indicated that

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before claim d subject matter can prop rly be c mpar d to the prior art, it is essential to know what the claims do in fact cover. See, e.g., the following decisions: In re Steele, 305 F 2d. 859, 134 USPQ 292 (CCPA 1962); In re Moore 439 F 2d. 1232, 169 USPQ 236 (CCPA 1969); In re Merat, 519 F 2d. 1390, 186 USPQ 471 (CCPA 1975).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 is rejected under 35 U.S.C. 102(b) as anticipated by Gori U.S. 4,784,861. The reference clearly teaches a composition within the scope of the claimed invention.

5. References are cited related to the state of the art. Any one or more of the references may be applied to the claims upon any amendments to overcome the above rejection under 35 U.S.C. 112 second paragraph.

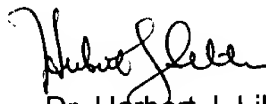
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6. **No claim is allowed.**

Will consider allowing claims drawn to the processes in which the fibers are prepared according to pages 6-7 of the specification since the references alone or further in view of each other do not suggest or motivate one of ordinary skill in the art to prepare the claimed combinations which mixtures have the unexpected results compared to the individual fibers.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner Lilling whose telephone number is (703) 308-2034 and Fax Number is for applications Before Final (703) 872-9306 and After Final for applications is 703-872-9307 or SPE Michael Wityshyn whose telephone number is (703) 308-4743.** Examiner can be reached Monday-Thursday from about 5:30 A.M. to about 3:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

H.J.Lilling: HJL
(703) 308-2034
Art Unit **1651**
March 10, 2003



Dr. Herbert J. Lilling
Primary Examiner
Group 1600 Art Unit 1651